

Remarks

The non-final Office Action dated September 28, 2010, indicated that prosecution was reopened from appeal, and presented the following new rejections: claims 15-19 and 26 stand rejected under 35 U.S.C. § 102(e) over Nelson *et al.* (US 6,628,644); and claims 1-14, 20-25 and 27 stand rejected under 35 U.S.C. § 103(a) over Fandrianto *et al.* (US 7,006,455) in view of the '644 reference. Applicant respectfully traverses all rejections, and unless explicitly stated otherwise herein, does not acquiesce to any rejection or averment made in the Office Action.

Applicant submits that the § 103(a) rejection of claims 1-14, 20-25 and 27 over the '455 reference is improper because the Office Action has not established that the '455 reference is prior art. Specifically, the '455 reference was filed on October 21, 2000 and the filing date of the instant application is June 16, 2000. In addition, while the '455 reference claims the benefit of provisional application No. 60/161,168 (filed on October 22, 1999), the Office Action has not established that this provisional application supports the disclosure relied upon in the rejections. While believed unnecessary to render the instant rejection invalid, Applicant has reviewed the '168 provisional application and notes that the description in the '455 reference appears to be significantly different than the description in the '168 provisional application. Applicant cannot ascertain disclosure of all of the claim limitations to which the instant Office Action refers in asserting correspondence to the '455 reference. Moreover, the '455 reference lists only one of the eight inventors (Fandrianto) listed in the provisional application, and also lists a new inventor (Sin). It is thus unclear as to how the Office Action may be asserting that the '455 reference would be prior art in view of the '168 provisional application or otherwise.

Accordingly, Applicant believes that no valid rejection of claims 1-14, 20-25 and 27 remains, and requests that the § 103(a) rejection be removed. Should any further rejection concerning the '455 reference be set forth, Applicant requests that such a rejection be made in a non-final form to afford the Applicant an opportunity to assess any such rejection and to respond thereto.

Applicant also traverses both the §§ 102(e) and 103(a) rejections because the Office Action has not established that either the '644 reference or the '455 reference is prior art in view of the § 1.131 Declarations of record (submitted with Office Action Response dated

May, 2007). Specifically, rejections under 102(e) and/or 103(a) are overcome based on a Rule 1.131 Declaration where the inventors have established that they were in possession of the invention (as the basic inventive concept) before the priority date of the asserted reference(s). This is explained in the M.P.E.P., for example, at Sections 715.02 and 715.03, which cite various authoritative decisions to explain that the priority entitlement issue turns on whether the inventor had “possession of the invention (*i.e.*, the basic inventive concept).”¹ In this instance, neither the ‘644 reference nor the ‘455 reference is prior art relative to the earlier invention date established through the previously-entered Rule 1.131 Declaration. Accordingly, the rejections should be withdrawn.

As applicable here and specifically referring to the Office Action mailed on April 30, 2008, the Examiner indicated that the Declaration “filed 2/5/2008 is sufficient to overcome the rejection of claims 1-22 based upon filing date (August 24, 1999). . . .” This August, 1999 date antedates the filing date of the ‘644 reference (September 30, 1999) and the filing date of the ‘168 provisional application (October 22, 1999) listed in the ‘455 reference. As consistent with the above discussion and cited portions of the M.P.E.P., relevant aspects of the aforesaid Declaration indicate:

Regarding the independent claims (*i.e.*, claims 1, 15 and 20), page 10 of Exhibit B shows an IntraSwitch PBX (*i.e.*, a control center) that is communicatively coupled to a PC, an IP phone, a video phone, etc. (*i.e.*, a plurality of IP telephony devices). The PC has a display and a user interface that allows a user to configure the IntraSwitch PBX and the other IP telephony devices. Per pages 17 and 18 of Exhibit B, the system provides for user and administration configuration (*i.e.*, control and configuration of the control center and the plurality of IP telephony devices), and further provides various types of user control over telephony communications.

Considering the above and in particular view of the lack of any indication (in the Office Action or otherwise) that these Declarations would not apply to the current claims, Applicant would understand that the record does not support the rejections as they stand. This is also consistent with a telephone message left with the Examiner by Applicant’s undersigned representative. Accordingly, Applicant requests that all of the §§ 102(e) and

¹ MPEP explains that the claims need not be identical in view of the showing of “possession” of the core aspects of the invention: explains, assuming any differences would have been obvious, the “differences between the claimed invention and the showing” are unimportant (MPEP 715.02-03).

103(a) rejections be removed. Should the Examiner have any questions regarding this matter, Applicant invites the Examiner to telephone the undersigned.

While Applicant believes that further discussion regarding the '644 reference and the §§ 102(e)/103(a) rejections is unnecessary in view of the above, Applicant further traverses the rejections because the Office Action has not established that the '644 reference corresponds to the claim limitations as asserted. Using the Office Action's discussion (at page 3) of the § 102(e) rejection of independent claim 15 as an example, cited column 7:66-9:3 of the '644 reference appears to be directed to user-control of telephony functions carried out at a call manager (26) for the user's IP phone (22a), with the call manager (remotely, actively) controlling the functions of the IP phone (*see, e.g.*, column 8:4-9). The IP phone determines whether call manager intervention is required and, if so, relays a corresponding signal (*see, e.g.*, column 8:6-10). These cited portions do not appear to disclose limitations directed to user-control of the call manager to program specific telephony devices. Further, none of the processor, memory or other components of the IP phone at the cited portions of columns 6 and 7 of the '644 reference appear to be programmed by the call manager, or otherwise correspond to the claimed invention as asserted in the Office Action.

In view of the above, the § 102(e) rejection of independent claim 15 and claims 16-19 and 26 that depend therefrom is improper for failing to establish correspondence. Moreover, the § 103(a) rejections of other independent claims relying upon similar rationale and the corresponding portions of the '644 reference thus also fail. Applicant therefore submits that the §§ 102(e) and 103(a) rejections relying upon the '644 reference fail to establish correspondence to, or teaching or suggestion of, the claimed invention. Applicant therefore requests that all of the rejections should be removed.

In view of the above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any

remaining issues that could be readily addressed over the telephone, the Examiner is encouraged to contact the undersigned at (651) 686-6633.

Respectfully submitted,

CRAWFORD MAUNU PLLC
1150 Northland Drive, Suite 100
St. Paul, MN 55120
651/259-2300

Dated: December 27, 2010

By: 

Robert J. Crawford
Reg. No. 32,122
Eric J. Curtin
Reg. No. 47,511

Encl: Copy of § 1.131 Declaration